

MAR-31-2003 15:11

15134217269

#18/Response
P.04
Lounan

PATENT

IBM/02B
Confirmation No. 9272

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

4-2-03

Applicant: Joseph Phillip Bigus et al. Art Unit: 3621
Serial No.: 09/431,833 Examiner: Firmin Backer
Filed: November 2, 1999 Atty. Docket No.: IBM/02B
For: INTELLIGENT AGENT WITH NEGOTIATION CAPABILITY AND METHOD
OF NEGOTIATION THEREWITH

RESPONSE

Box NON-FEE AMENDMENT
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This paper is submitted in reply to the Office Action dated December 30, 2002, within the three-month period for response (as March 30, 2003 is a Sunday). Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, claims 54-64 and 104-112 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. No. 550,145 to Hoffman et al.¹

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained.

Now turning to the Examiner's rejections, and in particular to that of independent claim 54, the claim generally recites a method of identifying an unknown party interacting with an intelligent agent. The method includes determining at least one attribute related to the unknown party, comparing the attribute for the unknown party with the attributes related to a plurality of

¹ The specific rejection refers to U.S. Patent No. 5,550,145 to Hoffman et al. Applicants assume, however that this reference was incorrect, as the cited patent number is for a patent for an antimicrobial composition, and as the Examiner's 892 Form refers to a U.S. Patent No. 5,613,012 to Hoffman et al. If Applicants' understanding is incorrect, Applicants request that the Examiner note this in the Examiner's next communication.

known parties, and identifying the unknown party as the known party having the attribute which most closely matches that of the unknown party.

The Examiner rejected claim 54 based upon Hoffman et al.; however, the reference is completely silent with respect to intelligent agents. Instead, the reference discloses a method of identifying a party interacting with a financial institution using biometrics, e.g., to validate smart card transactions at ATM's and the like. Indeed, the undersigned did a search of the text of Hoffman et al., and found no reference to "agents" or "intelligent agents" in the entirety of the reference.

Intelligent agents, within the context of the invention, are described in detail at pages 3-4 of the application, and may generally be considered to be relatively autonomous computer programs that may also be mobile in nature, e.g., so that they may be communicated and run on remote computers. There is no disclosure in Hoffman et al. that is even arguably analogous to a method of identifying an unknown party interacting with a computer program having the characteristics of an intelligent agent.

In rejecting claim 54, the Examiner appears to interpret claim 54 to cover any identification of an unknown party interacting with a computer. However, claim 54 is specifically directed to identifying an unknown party interacting with a specific type of computer program – an intelligent agent. Under a proper interpretation of the claim, Hoffman et al. (which does not even mention the use of intelligent agents) cannot be found to anticipate claim 54.

Furthermore, given that there is no suggestion in the reference to apply its biometric identification methodology to an intelligent agent application, Applicants also submit that claim 54 is non-obvious over the reference. Reconsideration and allowance of claim 54, and of claims 55-59 which depend therefrom, are therefore respectfully requested.

Next, with regard to independent claims 60 and 61, each of these claims likewise recites the identification of an unknown party interacting with an intelligent agent through the comparison of attributes determined for an unknown party with attributes related to a plurality of known parties. Claims 60 and 61 are therefore novel and non-obvious over Hoffman et al. and

the other prior art of record for the same reasons as presented above for claim 54.

Reconsideration and allowance of these claims, as well as of claims 62-63 and 104-112 which depend therefrom, are therefore respectfully requested.

As a final matter, Applicants also wish to separately address a number of dependent features recited in the claims, which impart patentability to these claims above and beyond that imparted by virtue of the claims' dependency upon claims 54, 60 and 61.

At the outset, it is noted that the Examiner cites the identical passages in Hoffman et al. to reject every pending claim. Furthermore, the Examiner's reasons for rejecting many of the claims are entirely conclusory in nature, with each consisting of nothing more than a repetition of the claim language and a citation of the identical passages in Hoffman et al. It is the burden of the Examiner to specifically apply the teachings of the references to the rejected claim language in order to support an art-based rejection. The Examiner has not done this with regard to the dependent claims, and Applicants therefore submit that the rejections are deficient on their face.

Moreover, with respect to many of the dependent claims, Applicants submit that the Examiner simply cannot find analogous teachings to the claimed subject matter. For example, with regard to claims 57, 104, 105 and 110, which are all directed in part to the use of weighting factors, Applicants can find no teachings in the cited passages that disclose or suggest the use of weighting factors in connection with identifying an unknown party based upon a plurality of attributes.

In addition, with regard to claims 58, 106 and 111, which recite in part that the unknown party is an intelligent agent configured to conduct electronic transactions, Hoffman et al. discloses no functionality that would even arguably be capable of ascertaining the identity of a computer program such as an intelligent agent. Instead, Hoffman et al. is directed to identifying a human unknown party through the use of biometrics, which is defined by Webster as "the statistical study of biological phenomena." Examples of biometric techniques in Hoffman et al. include "finger prints, hand prints, voice prints, retinal images, handwriting samples and the like" (Col. 4, lines 22-24). Biometric analysis is irrelevant for ascertaining the identity of an

intelligent agent or any other computer program. As such, Applicants respectfully submit that the biometric techniques described in Hoffman et al. fall far short of disclosing or suggesting the identification of an intelligent agent configured to conduct electronic transactions, as recited in claims 58, 106 and 111.

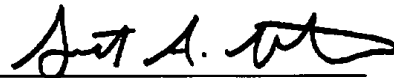
Likewise, with respect to claims 59, 107 and 112, these claims recite in part scanning program code for an intelligent agent unknown party to determine attributes thereof. Applicants respectfully submit that Hoffman et al.'s disclosure of a biometric technique for identifying an unknown person does not even arguably suggest the scanning of program code to ascertain the identity of an intelligent agent or other computer program.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

31 MARCH 2003

Date



Scott A. Stinebruner
Reg. No. 38,323
WOOD, HERRON & EVANS, L.L.P.
2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202
(513)241-2324

MAR-31-2003 15:09

15134217269

FAX RECEIVED

P.01

APR 01 2003

GROUP 3600

WOOD, HERRON & EVANS, L.L.P.

JOHN D. POFFENBERGER
BRUCE TITTEL
DONALD F. FREI
DAVID J. JOSEPHIC
DAVID S. STALLARD
J. ROBERT CHAMBERS
GREGORY J. LUNN
KURT L. GROSSMAN
CLEMENT H. LUKEN, JR.
THOMAS J. BURGER
GREGORY F. AHRENS
WAYNE L. JACOBS
KURT A. SUMME
KEVIN G. ROONEY
KEITH R. HAUPT
THEODORE R. REMAKLUS
THOMAS W. HUMPHREY
SCOTT A. STINEBRUNER
DAVID H. BRINKMAN
OF COUNSEL
THOMAS W. FLYNN

2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OHIO 45202-2917
TELEPHONE: 513-241-2324
FACSIMILE: 513-421-7269
EMAIL: info@whepatent.com
PATENT, TRADEMARK, COPYRIGHT
AND UNFAIR COMPETITION LAW
AND RELATED LITIGATION
EDMUND P. WOOD 1923-1968
TRUMAN A. HERRON 1935-1978
EDWARD B. EVANS 1936-1971

Official

JOSEPH R. JORDAN
C. RICHARD EBY
DAVID E. PRITCHARD
J. DWIGHT POFFENBERGER, JR.
BEVERLY A. LYMAN, PH.D.
KATHRYN E. SMITH
KRISTI L. DAVIDSON
P. ANDREW BLATT, PH.D.
DAVID E. JEFFERIES
WILLIAM R. ALLEN, PH.D.
JOHN P. DAVIS
DOUGLAS A. SCHOLER
BRETT A. SCHATZ
ALLISON A. DAVIDSON
MICHELLE D. NOBBE
DAVID W. DORTON
RONALD J. RICHTER, M.D.
SARAH OTTE GRABER
TECHNICAL ADVISORS
HENRY M. LABODA, PH.D.
LARRY D. MOORE, B.S.E.E.
G. PRABHAKAR REDDY, M.S.CH.

March 31, 2003

FACSIMILE COVER SHEET

To: Examiner Firmin Backer
Assistant Commissioner for Patents
Washington, D.C. 20231

From: Scott A. Stinebruner
Reg. No. 38,323

Fax: 703-746-7239

Re: U.S. Patent Application
Serial No. 09/431,833
Filed: November 2, 1999
Applicant: Joseph Phillip Bigus et al.
Art Unit: 3621
Confirmation No.: 9272
Our Ref: IBM/02B

Enclosures:

Fax Cover Sheet containing Certificate
of Facsimile Transmission
Transmittal containing Certificate of 3603
Facsimile Transmission

Response

Pages: 7 (including cover sheet)

MESSAGE/COMMENTS

OFFICIAL

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and the enclosures noted herein (7 total pages) are being transmitted via facsimile transmission to Examiner Firmin Backer, Assistant Commissioner for Patents, Washington, D.C. 20231 at 703-746-7239 on March 31, 2003.

Judith L. Volk
Judith L. Volk

March 31, 2003
Date

The information in this facsimile message is ATTORNEY-CLIENT PRIVILEGED, WORK PRODUCT and/or CONFIDENTIAL INFORMATION intended only for the use of the individual or entity to whom this message is addressed. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination, distribution or reproduction of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone and return the original message to us at the above address via mail. Thank you. If transmission is interrupted or of poor quality, please notify us immediately by calling (513) 241-2324 and ask for the sender's assistant. OUR FAX NUMBER IS (513) 421-7269.

MAR-31-2003 15:10

15134217269

FAX RECEIVED
P.02

APR 01 2003

GROUP 3600
PATENT

Att'y Docket No. IBM/02B/124
Confirmation No. 9272

Official

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and the enclosures noted herein (7 total pages) are being transmitted via facsimile transmission to Examiner Firmin Backer, Assistant Commissioner for Patents, Washington, D.C. 20231 at 703-746-7239 on March 31, 2003.

Judith L. Volk
Judith L. Volk

March 31, 2003
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Joseph Phillip Bigus et al. Art Unit: 3621
Serial No.: 09/431,833 Examiner: Firmin Backer
Filed : November 2, 1999
For : INTELLIGENT AGENT WITH NEGOTIATION CAPABILITY AND METHOD
OF NEGOTIATION THEREWITH

Box NON-FEE AMENDMENT
Assistant Commissioner for Patents
Washington, DC 20231

AMENDMENT TRANSMITTAL

1. ☒ Transmitted herewith is a Response.
2. ☐ Small Entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
☐ Enclosed is a verified statement to establish Small Entity status
☒ Other than a Small Entity
3. The fee has been calculated as shown below:

CALCULATION OF FEES

| Fee: | Number of Claims After Amendment: | | Previously Paid For: | No. Extra: | At Rate: | Amount: |
|------------------------------|--------------------------------------|-------|----------------------|------------|----------|---------|
| Total Claims | 19 | minus | 20 | 0 | \$18 | \$0.00 |
| Independent Claims | 3 | minus | 3 | 0 | \$84 | \$0.00 |
| MULTIPLE DEPENDENT CLAIM FEE | | | | | \$280 | \$0.00 |
| TOTAL FEE FOR CLAIMS: | | | | | | \$0.00 |

- ☒ No additional fee for claims is required.

Page 1 of 2
Serial No. 09/431,833
IBM Docket: RO996054L
WH&E IBM/02B
Transmittal for Response 2
K:\ibm\02B\Response 2 Transmitted.wpd

4. ☐ Attached is a check in the sum of \$_____ for additional claims.
☐ Please charge my Deposit Account No. 23-3000 in the amount of \$_____.
5. **The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply. Complete (a) or (b) as applicable.**

- ☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 for the total number of months checked below:

| | <u>Ext. Mos.</u> | <u>Large entity</u> | <u>Small entity</u> |
|--------------------------|------------------|---------------------|---------------------|
| <input type="checkbox"/> | one month | \$ 110.00 | \$ 55.00 |
| <input type="checkbox"/> | two months | \$ 410.00 | \$ 205.00 |
| <input type="checkbox"/> | three months | \$ 930.00 | \$ 465.00 |
| <input type="checkbox"/> | four months | \$1,450.00 | \$ 725.00 |
| <input type="checkbox"/> | five months | \$1,970.00 | \$ 985.00 |

Extension fee due with this request:

\$_____

Method of Payment:

Check enclosed in the amount of \$_____

If an additional extension of time is required, please consider this a petition therefor.

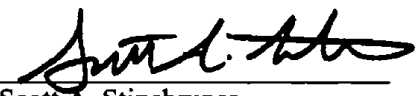
(Check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured and the fee paid thereof of \$_____ is deducted from the total fee due for the total months of extension now requested. Extension fee due with this request \$_____.
- OR**
- ☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.
6. ☒ If any additional fee for claims or extension of time is required, charge Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By:


Scott A. Stinebruner
Reg. No. 38,323

2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202-2917
(513) 241-2324

Enclosed:

Fax Cover Sheet containing Certificate of Facsimile Transmission
Transmittal containing Certificate of Facsimile Transmission
Response